

REMARKS

In response to the above-identified Office Action (“Action”), Applicant traverses the Patent Office’s rejection to the claims and seeks reconsideration thereof. Claims 1-23 are now pending in the present application. Claims 14-18 have been withdrawn. In this response, no claims have been amended, no claims have been added and no claims have been cancelled.

I. Claim Rejections – 35 U.S.C. §102

In the outstanding Action, Claims 1, 4-9, 13 and 19-23 are rejected under 35 U.S.C. §102(b) as being anticipated by, U. S. Patent No. 3,645,279 issued to Imre (“Imre”). Applicant respectfully traverses the rejections.

It is axiomatic to a finding of anticipation that a reference teach each and every element of the claims. In regard to Claim 1, Applicant respectfully submits Imre fails to teach or suggest at least the elements of “a generally peripheral member sized to be worn on less than an entire portion of a scalp of a human head and enclose an occipital portion and a parietal portion of the human head” and “a plurality of diagonal members each respectively coupled to the longitudinal member and the peripheral member distal from the longitudinal member” as recited in Claim 1.

The Patent Office alleges the elliptical member 25b shown in Figure 8 inherently meets the claimed language of “a generally peripheral member sized to be worn on less than an entire portion of a scalp of a human head and enclose an occipital portion and a parietal portion of the human head” as there exists humans having different sizes of anatomies. See Action, page 3. Applicant respectfully disagrees that a peripheral member including this criteria is inherent. Claim 1 states that the peripheral member has a size defined in such a way to be worn on less than an entire portion of a scalp or a human head. The peripheral member also has a size defined in such a way to enclose an accepted portion and a parietal portion of a human head.

Imre teaches a wig having an elliptical member 25 including netting 16 extending around the sides of the user's head and connected at the ends by an elastic strip 24. See Imre, col. 26-49. Imre further teaches that wefts are sewn at the front of the user's head to give the impression of a thick head of hair and designed to engage the user's head. See Imre, col. 1, lines 45-47; col. 2, lines 30-35; Fig. 1. Imre does not teach the use of any sort of securing mechanism other than the tension created from the elastic strip 24. Thus, in order for the wefts to be positioned at the front of the user's head and tension from the elastic strap to hold the wig on the user's head, the elastic strip 24 at the end of the wig must be positioned at the opposite end of the user's head. Thus, in as much as the wig must be sized to fit an entire portion of the scalp of a human in order for it to remain on the user's head and function as described, the wig of Imre does not necessarily teach a "generally peripheral member sized to be worn on less than an entire portion of a scalp of a human head" as recited in claim 1. Accordingly, regardless of the size of the head of the user, Imre does not inherently teach at least this element of claim 1.

The Patent Office alleges strips 28b shown in Fig. 8 of Imre teach the recited plurality of diagonal members and points to a single strip 28b at the front of the wig. See Action, page 3. Applicant respectfully submits a single strip does not teach a plurality of diagonal members as recited in Claim 1. Moreover, Imre teaches the strips 28b extend between legs 20b and lie within parallel planes which are perpendicular to the major axis of elliptical member 25b. See Imre, col. 4, lines 14-19, Fig. 8. As can be seen from any standard dictionary, the term "diagonal" refers to geometric lines that are neither parallel nor perpendicular. See, for example, *The American Heritage® Dictionary of the English Language*, Fourth Edition, (2000). Thus, the strips taught in Imre may not be characterized as "diagonal members respectively coupled to the longitudinal member and peripheral member" as recited in Claim 1. Moreover, as is illustrated, for example, in Figure 8, the claimed configuration of the diagonal members with respect to the longitudinal and peripheral members results in geometric regions of a shape and size to allow the wearer to pull enough of the wearer's natural hair through the geometric regions to enhance a hair style formed by the wefts coupled to the diagonal members. See Application, page 11, paragraph [0044], Figure 8. In contrast, in Imre, the parallel planes within the elliptical base are relatively narrow such that, in some cases, a crochet hook is used to pull hair through the spaces. See Imre,

col. 3, lines 44-45; Figure 2. Accordingly, it is evident that only a small amount of the user's hair is pulled through the spaces such that it creates nothing more than a streaking effect. See Imre, col. 3, lines 39-40. Thus, Imre does not teach a wig configuration having geometric regions which allow the natural hair to enhance a style of the wig. For at least the foregoing reasons, Imre fails to teach each and every element of claim 1. Since each and every element of claim 1 is not taught by Imre, anticipation may not be found. For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §102(b).

In regard to Claim 19, Applicant respectfully submits Imre fails to teach at least the elements of "applying outside pressure to a foundation of the device to cause the foundation of the device to conform to the contours of an individual wearer's head." The Patent Office alleges this element is taught by the pulling of legs 20 in Imre down which in turn inherently causes base 14 to conform to the wearer's head. See Action, page 5. Applicant respectfully disagrees with the Patent Office's characterization. Much like the elastic netting of the Williams (USPN 4,386,619) reference, which the Patent Office withdrew, it is the tension created by the elasticity of the components of base 14 (e.g. legs 20 and elastic strip 24) which conform base 14 to the contours of the wearers head, not pulling legs 20 in a downward direction. Thus, in as much as it is the tension from components of base 14 which conform base 14 to the user's head, the Patent Office has not shown an outside pressure to a foundation necessarily conforms a foundation to a user's head as required by claim 19. Thus, for at least the foregoing reasons, Imre neither explicitly nor inherently teaches at least this element of claim 19. Since each and every element of claim 19 is not taught by Imre, anticipation may not be found. For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 19 under 35 U.S.C. §102(b).

In regard to claims 4-9, 13 and 20-23, claims 1-9 and 13 depend from claim 1 and claims 20-23 depend from claim 19 and incorporate the limitations thereof. Thus, for at least the reasons discussed in regard to claims 1 and 19, Imre fails to teach each and every element of claims 4-9, 13 and 20-23. Since each and every element of the claims is not taught by Imre,

anticipation may not be found. For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 4-9, 13 and 20-23 under 35 U.S.C. §102(b).

II. Claim Rejections – 35 U.S.C. §103(a)

A. In the outstanding Action, Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Imre in view of U. S. Patent No. 3,628,546 issued to Ensminger ("Ensminger"). Applicant respectfully traverses the rejections.

To establish a *prima facie* case of obviousness, the Patent Office must show that the cited reference teaches or suggests each of the elements of a claim. Hindsight reconstruction may not be used to modify the reference to meet the claimed invention. MPEP §2145. Furthermore, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art, without some showing of an objective reason for modifying the reference to arrive at the claimed invention, is not sufficient to establish a *prima facie* case of obviousness. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

In regard to claim 2, claim 2 depends from claim 1 and incorporates the limitations thereof. Thus, for at least the reasons discussed in the traversal of claim 1 over Imre, Imre fails to teach or suggest at least the elements of “a generally peripheral member sized to be worn on less than an entire portion of a scalp of a human head and enclose an occipital portion and a parietal portion of the human head” and “a plurality of diagonal members each respectively coupled to the longitudinal member and the peripheral member distal from the longitudinal member” as incorporated into claim 2. Moreover, the Patent Office has not pointed to and Applicant is unable to discern a portion of Ensminger curing the deficiencies of claim 2 with respect to these elements.

Applicant further submits there is no motivation to combine Imre with Ensminger to teach the element of “the peripheral member comprises a wire” as further recited in claim 2. Ensminger discloses an undulated wire strip to form hairpieces such as wiglets which covers only

a minimal amount of scalp and hair of the wearer. See Ensminger, col. 1, lines 36-50, col. 2, lines 24-25. The Patent Office alleges it would have been obvious to one of ordinary skill in the art to incorporate the undulated wire frame 10 of Ensminger into the device of Imre to enhance durability and flexibility to the device. See Action, page 6. Applicant respectfully submits, it is unclear how a wire bent back and forth on itself to form a planar band as shown in Ensminger may be incorporated into the elliptical base member of Imre. In any case, Imre teaches away from such a modification. Imre discloses a full wig having a base which resiliently engages and encircles the user's head. See Imre, Figs. 1-6. Imre further teaches that a disadvantage of the prior art wigs is that their bases are not sufficiently elastic to obtain a comfortable fit. See Imre, col. 1, lines 17-23. Based on the foregoing teachings of Imre, one of ordinary skill in the art would not be motivated to replace the resilient elliptical base of Imre which achieves a comfortable fit with an unresilient wire member that prevents such a fit. Thus, for at least the foregoing reasons, there is no motivation to combine Imre and Ensminger in the manner relied upon by the Examiner.

Thus, for at least the foregoing reasons, neither Imre nor Ensminger, alone or in combination, may be relied upon to teach each and every element of claim 2. Since the references fails to teach or suggest each and every element of claim 2, a *prima facie* case of obviousness may not be found. For the foregoing reasons, Applicant respectfully requests withdrawal of the rejection of claim 2 under 35 U.S.C. §103.

B. In the outstanding Office Action, Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Imre in view of U. S. Patent No. 5,873,373 issued to Narvick ("Narvick"). Applicant respectfully traverses the rejections.

In regard to claim 3, claim 3 depends from claim 1 and incorporates the limitations thereof. Thus, for at least the reasons discussed in the traversal of claim 1 over Imre, Imre fails to teach or suggest at least the elements of "a generally peripheral member sized to be worn on less than an entire portion of a scalp of a human head and enclose an occipital portion and a parietal portion of the human head" and "a plurality of diagonal members each respectively coupled to the longitudinal member and the peripheral member distal from the longitudinal

member” as incorporated into claim 3. Moreover, the Patent Office has not pointed to and Applicant is unable to discern a portion of Narvick curing the deficiencies of claim 3 with respect to these elements. Thus, for at least the foregoing reasons, neither Imre nor Narvick, alone or in combination, may be relied upon to teach each and every element of claim 3. Since the references fails to teach or suggest each and every element of claim 3, a *prima facie* case of obviousness may not be found. For the foregoing reasons, Applicant respectfully requests withdrawal of the rejection of claim 3 under 35 U.S.C. §103.

C. In the outstanding Action, claims 10-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Imre in view of U. S. Patent No. 3,435,832 issued to Yonezo Ito ("Yonezo"). Applicant respectfully traverses the rejections.

Claims 10-12 depend from claim 1 and incorporates the limitations thereof. Thus, for at least the reasons discussed in regard to claim 1, Imre fails to teach or suggest at least the elements of “a generally peripheral member sized to be worn on less than an entire portion of a scalp of a human head and enclose an occipital portion and a parietal portion of the human head” and “a plurality of diagonal members each respectively coupled to the longitudinal member and the peripheral member distal from the longitudinal member” as found in claims 10-12. Moreover, the Patent Office has not pointed to and Applicant is unable to discern a portion of Yonezo curing the deficiencies of Imre with respect to these elements. Thus, for at least the foregoing reasons, neither Imre nor Yonezo, alone or in combination, may be relied upon to teach each and every element of claims 10-12. Since the references fails to teach or suggest each and every element of claims 10-12, a *prima facie* case of obviousness may not be found. For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 10-12 under 35 U.S.C. §103.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely Claims 1-23, are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. Questions regarding this matter should be directed to the undersigned at (310) 207-3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: June 9, 2006

By: William T. Babbitt
William Thomas Babbitt, Reg. No. 39,591

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on June 9, 2006.

Jean Svoboda
Jean Svoboda